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46718	7590	02/27/2009	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP (018563) TWO EMBARCADERO CENTER, EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			NAJARIAN, LENA	
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1                   UNITED STATES PATENT AND TRADEMARK OFFICE

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4                   BEFORE THE BOARD OF PATENT APPEALS  
5                   AND INTERFERENCES

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8                   *Ex parte MUHAMMAD CHISHTI, KENNETH VARGHA,*  
9                   and JOE BREELAND

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12                   Appeal 2008-4117  
13                   Application 09/756,885  
14                   Technology Center 3600

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17                   Decided:<sup>1</sup> February 27, 2009

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20                   *Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R.*  
21                   *MOHANTY, Administrative Patent Judges.*

22

23                   *CRAWFORD, Administrative Patent Judge.*

24

25                   DECISION ON APPEAL

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27                   STATEMENT OF THE CASE

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1       Appellants appeal under 35 U.S.C. § 134 (2002) from a Final  
2 Rejection of claims 1 to 30 and 46 to 59. We have jurisdiction under 35  
3 U.S.C. § 6(b) (2002).

4       Appellants invented a method for distributing patient referrals  
5 (Specification 1).

6       Claim 1 under appeal reads as follows:

7  
8       1. A method for referring patients to  
9       practitioners, said method comprising:  
10       certifying a group of practitioners to perform  
11       a medical procedure;  
12       identifying individual patients who wish to  
13       receive the procedure;  
14       accessing an electronic database having  
15       information comprising a number of procedures  
16       performed by each of the group of certified  
17       practitioners; and  
18       providing to the identified individual patients  
19       a list of certified practitioners, selected from the  
20       electronic database, wherein those practitioners  
21       who have performed more procedures than others  
22       of the practitioners are placed preferentially on the  
23       list.  
24

25       The Examiner rejected claims 1 to 5, 12, and 13 under 35 U.S.C. §  
26 103(a) as being unpatentable over DeBruin-Ashton in view of Falchuk and  
27 Tawil.

28       The Examiner rejected claims 6 to 11 under 35 U.S.C. § 103(a) as  
29 being unpatentable over as being unpatentable over DeBruin-Ashton in view  
30 of Falchuk, Tawil and Kurzus.

31       The Examiner rejected claims 14, 16 to 19, 21, 22, 29 and 30 under 35  
32 U.S.C. § 103(a) as being unpatentable over DeBruin-Ashton in view of Joao.

1        The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being  
2 unpatentable over DeBruin-Ashton in view of Joao and Tawil.

3        The Examiner rejected claim 20 under 35 U.S.C. § 103(a) as being  
4 unpatentable over DeBruin-Ashton in view of Joao and Falchuk.

5        The Examiner rejected claims 23 to 28 under 35 U.S.C. § 103(a) as  
6 being unpatentable over DeBruin-Ashton in view of Joao, Tawil and  
7 Kurzius.

8        The Examiner rejected claims 46 to 49, 51, 52, 55, 56 and 58 under 35  
9 U.S.C. § 103(a) as being unpatentable over Tawil in view of Falchuk.

10       The Examiner rejected claims 50 and 59 under 35 U.S.C. § 103(a) as  
11 being unpatentable over Tawil in view of Falchuk and DeBruin-Ashton.

12       The Examiner rejected claims 53, 54 and 57 under 35 U.S.C. § 103(a)  
13 as being unpatentable over Tawil in view of Falchuk and Kurzius.

14       The prior art relied upon by the Examiner in rejecting the claims on  
15 appeal is:

16              Tawil	US 5,225,976	Jul. 06, 1993
17              DeBruin-Ashton	US 6,014,629	Jan. 11, 2000
18              Joao	US 2002/0032583 A1	Mar. 14, 2002
19              Kurzius	US 6,385,620 B1	May 7, 2002
20              Falchuk	US 2002/0152096 A1	Oct. 17, 2002

21

## ISSUES

23        Have Appellants shown that the Examiner erred in finding that the  
24 prior art discloses or suggests a method comprising the step of providing to  
25 the identified individual patients a list of certified practitioners, selected  
26 from an electronic database, *wherein those practitioners who have*

1 performed more procedures than others of the practitioners are placed  
2 preferentially on the list?

3 Have the Appellants shown that the Examiner erred in finding that the  
4 prior art discloses or suggest a method comprising the step of providing to  
5 the identified individual patients a referral lists of certified practitioners,  
6 selected from the electronic database, *wherein individual practitioners are*  
7 *preferentially placed on the referral lists based on one or more performance*  
8 *criteria?*

6

## FINDINGS OF FACT

11 FF1. Appellants disclose a method of referring patients to  
12 practitioners for the performance of a new procedure (Specification 1). An  
13 object of Appellants' invention is to avoid over loading relatively  
14 inexperienced practitioners who might otherwise benefit from additional  
15 time and patient experience to develop skills in the new procedure  
16 (Specification 1). The Appellants disclose that a group of practitioners are  
17 first certified to perform the new procedure and the identification and  
18 contact information are collected and placed on a referral directory  
19 (Specification 8). The referral directory is periodically updated as additional  
20 practitioners are certified or removed. Performance criteria such as number  
21 of procedures will also be updated over time as practitioners gain experience  
22 (Specification 8). The method relies on preferential referral of certified  
23 practitioners based on the number of procedures that the practitioner has  
24 performed (Specification 8). Appellants disclose that tiers of levels within  
25 the referral directory are created based on the number of procedures

1 performed by the practitioners (Specification 9). In this regard, the  
2 practitioners with the most experience are placed in a higher tier and referred  
3 the greatest number of patients (Specification 9).

4 FF 2. DeBruin-Ashton discloses a method of referring patients to  
5 practitioners (col. 1, ll. 36 to 39). This includes the step of providing a list  
6 of practitioners from a practitioner database (col. 6, ll. 56 to 62). In the  
7 DeBruin-Ashton method, the patient may be provided a list of practitioners  
8 sorted by geographic area and specialty (col. 11, l. 19 to col. 12 l. 3). The  
9 method includes a step to reduce the number of practitioners listed to a  
10 threshold number (col. 12, ll. 32 to 36). This reduction step may include a  
11 random selection process to ensure that all practitioners are on average listed  
12 on an equal number of referral lists (col. 12, ll. 43 to 47). Alternately, other  
13 selection algorithms may be used for reducing the number of practitioners  
14 such as applying weighting factors to the selection process such that  
15 physicians who have newly joined the service plan are represented in higher  
16 proportion than practitioners that have been with the plan for an extended  
17 period of time (col. 12 , ll. 47 to 54). De-Bruin-Ashton does not disclose  
18 placing practitioners that have performed more procedures than others  
19 preferentially on the list.

20 FF 3. Tawii discloses an automated health benefit processing system  
21 (col. 1, l. 1). The system includes a database which includes background  
22 information concerning each practitioner such as medical specialty, board  
23 certification, number of years in practice, medical degrees with class rank,  
24 residency location, number of malpractice suits lost and number of times the  
25 practitioner has performed a procedure within a given amount of time (col.

1 3, ll. 3 to 18. The database can be sorted by individual medical procedure  
2 (col. 3, ll. 19 to 25). Tawaii does not disclose placing practitioners that have  
3 performed more procedures than others preferentially on a referral list.

4 FF 4. Falchuk discloses a medical consultation management system  
5 (col. 1, l. 1). The system includes a database of certified practitioners  
6 [paragraphs 0021, 0030]. Falchuk does not disclose placing practitioners  
7 that have performed more procedures than others preferentially on a referral  
8 list.

9 FF 5. Kurzius discloses a method for management of candidate  
10 recruiting information that includes a candidate proficiency form that may  
11 indicate both years of experience in a particular skill and a proficiency level  
12 chosen from a select list of terms such as beginner, intermediate, full-  
13 understanding and expert (col. 17, ll. 35 to 52). While Kurzius discloses that  
14 the candidate can rate themselves in tiers of beginner, intermediate, full-  
15 understanding or expert in skill areas, there is no disclosure that the tiers  
16 relate solely to the of number times the candidate has performed the skill.  
17 Kurzius does not disclose placing candidates that have performed the skill  
18 more times than others preferentially on a list. Kurzius does not relate to  
19 medical practitioners and thus discloses nothing about the number of times a  
20 practitioner has performed a procedure.

21 FF 6. Joao discloses dental and oral surgery training and a database  
22 containing statistical information such as treatment success rates and  
23 information on the treatment providers (paragraphs 159 and 161). Joao does  
24 not disclose placing candidates that have performed the skill more times than  
25 others preferentially on a referral list.

1 PRINCIPLES OF LAW

2 The test for obviousness is what the combined teachings of the  
3 references would have suggested to one of ordinary skill in the art. *See In re*  
4 *Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006); *In re Young*, 927 F.2d 588,  
5 591 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

6

7 ANALYSIS

8 *Obviousness of claims 1 to 5, 12 and 13*

9 We will not sustain the Examiner's rejection of these claims because  
10 the cited prior art does not disclose a method including the step of providing  
11 to the identified individual patients a list of certified practitioners, selected  
12 from an electronic database, *wherein those practitioners who have*  
13 *performed more procedures than others of the practitioners are placed*  
14 *preferentially on the list* as is required by claim 1 from which claims 2 to 5,  
15 12 and 13 depend. Although the Examiner is correct that DeBruin-Ashton  
16 discloses a step of using a selection algorithm that applies weighting factors  
17 to the selection process there is no disclosure that practitioners that have  
18 performed more procedures are placed preferentially on a list. In fact,  
19 DeBruin discloses that practitioners are listed so that they are all placed  
20 equally on lists in such a fashion that the new practitioner who would  
21 presumably have less experience are preferential placed lists (FF 2). While  
22 Tawil discloses that the database may include information about the number  
23 of procedures performed by each practitioner, there is no disclosure that  
24 there is a practitioner list that is ordered so as to give the practitioners who

- 1 have performed the procedure more often a preferential place on the list.
- 2 Falchuk does not cure the deficiencies of DeBruin-Ashton and Tawil.
- 3 In view of the foregoing, we will not sustain the Examiners rejection
- 4 of claims 1 to 5, 12 and 13 under 35 U.S.C. § 103 as being unpatentable over
- 5 DeBruin-Ashton, Falchuk and Tawil.

6 *Obviousness of claims 6 to 11*

7 Claims 6 to 11 depend from claim 1. As noted in the proceeding  
8 section, De-Bruin-Ashton, Falchuk and Tawil do not disclose the subject  
9 matter of claim 1 related to the step of placing practitioners who have  
10 performed more procedures preferentially on a list. Kurzius discloses a  
11 candidate proficiency form but does not disclose that the candidates are  
12 listed in accordance with the proficiency much less that practitioners are  
13 placed preferentially on a list. As such we will not sustain the Examiner's  
14 rejected of claims 6 to 11.

15 *Obviousness of claims 14, 16 to 19, 21 to 22, 29 and 30*

16 Claim 14 requires that the step of providing a referral lists of certified  
17 practitioners, selected from an electronic database, *wherein individual*  
18 *practitioners are preferentially placed on the referral lists based on one or*  
19 *more performance criteria.* The Examiner relies on DeBruin-Ashton for  
20 teaching forming a referral list based on one or more performance criteria  
21 (Answer 9). While DeBruin-Ashton does disclose using a selection  
22 algorithm to reduce the number of practitioners referred so that practitioners  
23 that have been with the program for a shorter length of time are placed on a  
24 list in higher proportion, DeBruin-Ashton does not disclose that the  
25 practitioners are placed on the list in accordance with one or more

1 performance criteria. In this regard, we note that DeBruin-Ashton does not  
2 disclose that the length of time with the program is related to a performance  
3 criteria. Joao does not cure this deficiency.

4 In view of the foregoing, we will not sustain this rejection.

5 *Obviousness of claim 15*

6 Claim 15 depends from claim 14. As noted above neither DeBruin-  
7 Ashton nor Joao discloses that practitioners are preferentially placed on a  
8 referral list based on one or more performance criteria. While Tawil  
9 discloses that the database may include information about the number of  
10 procedures performed by each practitioner, there is no disclosure that  
11 practitioners are placed on a list based on one or more performance criteria.

12 Therefore, we will not sustain the Examiner's rejection of claim 15.

13 *Obviousness of claim 20*

14 Claim 20 depends from claim 14. As stated above, neither DeBruin-  
15 Ashton nor Joao disclose or suggest the subject matter of claim 14. Falchuk  
16 does not cure the deficiencies of DeBruin-Ashton and Joao.

17 Therefore, we will not sustain the Examiner's rejection of claim 20.

18 *Obviousness of claims 23 to 28*

19 Claim 23 depends from claim 14. As stated above, neither DeBruin-  
20 Ashton, Joao nor Tawil disclose or suggest the subject matter of claim 14.  
21 While Kurzius discloses a candidate proficiency form that includes  
22 information about the experience and skill level of the candidate, Kurzius  
23 does not disclose that the candidates are preferentially listed based on the  
24 experience and skill level much less on one or more performance criteria.

1           Therefore, we will not sustain the Examiner's rejection of claims 23 to  
2   28.

3           *Obviousness of claims 46 to 49, 51, 52, 55, 56 and 58*  
4           Claim 46 from which claims 47 to 49, 51, 52, 55, 56 and 58 depend,  
5   includes language similar to claim 1 i.e., the step that practitioners are  
6   prioritized on a list based on the number of times each practitioner has  
7   performed the procedure. As we stated and found above, neither Tawil nor  
8   Falchuk discloses a method that includes a step of prioritizing a  
9   practitioner's position on a list based on the number of times the practitioner  
10   performed a procedure.

11          Therefore, we will not sustain this rejection.

12          *Obviousness of claims 50 and 59*  
13          Claims 50 and 59 are dependent on claim 46. As we have stated  
14   above, neither Tawil, Falchuk nor DeBruin-Ashton disclose that a  
15   practitioner is prioritized on a list based on the number of times the  
16   practitioner has performed a procedure. Therefore, we will not sustain this  
17   rejection.

18          *Obviousness of claims 53, 54 and 57*  
19          Claims 53, 54 and 57 depend from claim 46. As we have stated  
20   above, neither Tawil disclose that a practitioner is prioritized on a list based  
21   on the number of times the practitioner has performed a procedure. In  
22   addition, Kurzius discloses a candidate proficiency form but does not  
23   disclose that the candidates are listed in accordance with the number of  
24   times a practitioner has performed a procedure. Therefore, we will not  
25   sustain this rejection.

## CONCLUSION OF LAW

2 On the record before us, the Appellants have shown that the Examiner  
3 erred in finding that the prior art discloses or suggests a method comprising  
4 the step of providing to the identified individual patients a list of certified  
5 practitioners, selected from an electronic database, wherein those  
6 practitioners who have performed more procedures than others of the  
7 practitioners are placed preferentially on the list.

8 On the record before us, the Appellants have shown that the Examiner  
9 erred in finding that the prior art discloses or suggest a method comprising  
10 the step of providing to the identified individual patients referral lists of  
11 certified practitioners, selected from the electronic database, wherein  
12 individual practitioners are preferentially placed on the referral lists based on  
13 one or more performance criteria.

## DECISION

The Examiner's rejection of claims 1 to 30 and 46 to 59 is reversed.

**REVERSED**

22 hh

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